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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/930,364	08/15/2001	Michael L. Weiner	MLW-3	3436

37282 7590 08/25/2004

HOWARD J. GREENWALD P.C.  
349 W. COMMERCIAL STREET SUITE 2490  
EAST ROCHESTER, NY 14445-2408

EXAMINER
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EVANISKO, GEORGE ROBERT

ART UNIT	PAPER NUMBER
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3762

DATE MAILED: 08/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/930,364

Applicant(s)

WEINER ET AL.

Examiner

George R Evanisko

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 10 June 2004.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-10 and 12-20 is/are pending in the application.
- 4a) Of the above claim(s) 2-5, 8-10, 15, 17, 19 and 20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 6, 7, 12-14, 16 and 18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 7/25/03.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

Claims 2-5, 8-10, 15, 17, 19, and 20 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected embodiments, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 6/10/04.

#### ***Claim Objections***

Claims 1, 6, 7, 12-14, 16 and 18 are objected to because of the following informalities:

In claim 1, the means for sensing is not connected to any other part of the device and the claim seems to be a listing of parts. It is suggested to connect the means for sensing to another claimed element

In claim 16, "is comprised" should be "is further comprised" since the catheter is an additional element and not the entire apparatus. In addition, "from an external source" should be related to the means for emitting since they are the same element.

In claim 18, "further comprises" should be "comprises" since the apparatus is a neurostimulator.

Appropriate correction is required.

#### ***Claim Rejections - 35 USC § 102/103***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1, 6, 7, 12-14, 16 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lemelson (599378) in view of Zhou et al (5814078).

Lemelson discloses the claimed invention using a sensor, programmable computer for varying emitted energy, catheter, is capable of meeting the functional use recitation in claim 18 of including a neurostimulator since Lemelson can be used to stimulate the nerves and/or contains a capsule for the nerves (column 24), and photonic/laser energy that can be adjusted to optimize treatment (column 20) except for the exact waveform having a first peak value, decreasing to a second value, a third lesser peak value and a decreasing fourth value and the energy being mixtures of photonic and vibratory energy. Zhou teaches that it is known to have a waveform having a first peak value, decreasing to a second value, a third lesser peak value and a decreasing fourth value and Zhou teaches to use a broad spectrum of photonic and vibratory energy (column 7, lines 55-60 to elicit transitions and rotation of electrons, molecules and atoms), both to provide effective stimulation that improves the status of growth and survival of

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organisms. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the therapy system as taught by Lemelson, with a waveform having a first peak value, decreasing to a second value, a third lesser peak value and a decreasing fourth value and to use a broad spectrum of photonic and vibratory energy as taught by Zhou, since such a modification would provide a therapy system that has a waveform having a first peak value, decreasing to a second value, a third lesser peak value and a decreasing fourth value and to use a broad spectrum of photonic and vibratory energy, both to provide effective stimulation that improves the status of growth and survival of organisms.

In the alternative for claim 14, Lemelson in view of Zhou discloses the claimed invention except for the combination of photonic and vibratory and/or electrical energy. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the therapy system as taught by Lemelson in view of Zhou, with the combination of photonic and vibratory and/or electrical energy since it was known in the art that therapy systems use a combination of photonic and vibratory and/or electrical energy to provide a mixture of therapeutic energies that are more effective and quickly treat the patient.

Claims 1, 6, 7, and 12 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Nordenstroom (4919138). Nordenstroom states in column 4 that equipment for controlling the process may be provided for programming based on known or sensed values and therefore provides a programmable controller.

In the alternative, Nordenstroom discloses the claimed invention except for the programmable controller. It would have been obvious to one having ordinary skill in the art at

the time the invention was made to modify the stimulation system as taught by Nordenstroom, with the programmable controller since it was known in the art that stimulation systems use programmable controllers to easily change the stimulation parameters to fit the particular patient.

Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nordenstroom.

Nordenstroom discloses the claimed invention with electrodes implanted in the body except for the electrodes using a catheter being fed with energy from an external source. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the tissue stimulator as taught by Nordenstroom, with the electrodes using a catheter being fed from an external source since it was known in the art that tissue stimulators are provided with electrodes that use a catheter being fed from an external source to provide a percutaneous stimulation system that can precisely target an area in the body for therapy without the more invasive implantation of the stimulator.

Claims 1, 6, 7, 12, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nachum (6363284). Nachum applies his signal to restore electrical activity along the nervous system pathways and therefore includes/is a neurostimulator and discloses the claimed invention of adjusting the stimulation based on the sensing except for the programmable controller. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the electrical stimulation system as taught by Nachum, with a programmable controller since it was known in the art that electrical stimulation systems use a programmable

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controller to easily adjust the stimulation based on known or sensed values to provide effective therapy based on the particular patient and condition.

***Response to Arguments***

Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection necessitated by amendment.

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to George R Evanisko whose telephone number is 703 308-2612.

The examiner can normally be reached on M-F 6:30-5:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Angela Sykes can be reached on 703 308-5181. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

George R Evanisko  
Primary Examiner  
Art Unit 3762

8/22/04

GRE  
August 22, 2004